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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,239	06/01/2001	Carl Keith Smith	MIDR704	5401

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
1712	61

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-9

<b>Office Action Summary</b>	Application No.	763239	Applicant(s)	SMITH
	Examiner	P. TUCKER	Group Art Unit	1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- Responsive to communication(s) filed on \_\_\_\_\_
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 1 - 21 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) 12 - 21 is/are allowed.
- Claim(s) 1 - 11 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

**Application Papers**

- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All  Some\*  None of the:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

<input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). <u>6, 7</u>	<input type="checkbox"/> Interview Summary, PTO-413
<input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892	<input type="checkbox"/> Notice of Informal Patent Application, PTO-152
<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948	<input type="checkbox"/> Other _____

**Office Action Summary**

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. “Use of” is neither a process or a composition of matter..

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 teaches an additive, but later in the claim states that such additive is added to a wellbore, drilling or servicing fluid. It is thus not clear if the additive is being claimed or the composition.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Derand et al, Macromolecules, vol. 29, pages 8770-8775, (1996)..

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Derand teaches styrene-maleic anhydride copolymers comprising alkylene oxide side chains, as in the present invention, wherein such is used in water solutions (see Table 1).

Applicants intended use in a wellbore fluid does not distinguish over the prior art.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 306449.

EP '449 teaches the styrene-maleic anhydride copolymers comprising alkylene oxide side chains, as in the present invention, which thus anticipates applicants additive (see pages 2-3 and examples).

8. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 2312616.

DE '616 teaches the styrene-maleic anhydride copolymers comprising alkylene oxide side chains, as in the present invention, which thus anticipates applicants additive (see claims).

9. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wutz et al (5739212).

Wutz teaches the maleic anhydride copolymers comprising alkylene oxide side chains, as in the present invention, which thus anticipates applicants additive (see examples). Wutz further teaches their use in drilling fluids (column 5, lines 10-13).

10. Claims 12-21 are allowable over the art of record.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2671  
November 4, 2002

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**